

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS & INTERFERENCES**

In re Patent Application of:)	Confirmation No. 4901
Bret Alan GORSLINE , <i>et al.</i>)	Group Art Unit: 2178
Application No. 10/727,264)	Examiner: David Faber
Filed: December 3, 2003)	
For: METHODS AND SYSTEMS FOR)	Date: May 14, 2010
PROGRAMMABLY GENERATING)	
ELECTRONIC AGGREGATE)	
CREATIVES FOR DISPLAY ON AN)	
ELECTRONIC NETWORK)	

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APPEAL BRIEF

Sir:

The following Appeal Brief is submitted in support of the appeal proceedings instituted by a Notice of Appeal filed January 14, 2010, in response to the final Office Action mailed October 14, 2009 in connection with the above-captioned patent application.

I. REAL PARTY IN INTEREST

CBS Interactive Inc. is the real party in interest.

II. RELATED APPEALS AND INTERFERENCES

There are presently no appeals or interferences known to the Appellants, Appellants' representative, or the assignee, which will directly affect, or be directly affected by, or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 46-96 are currently pending in the application. Claims 1-45 have been cancelled. This Appeal is taken from the rejection of claims 46-96, as submitted in the Appendix herewith.

IV. STATUS OF AMENDMENTS

No amendments have been entered to the claims subsequent to the final Office Action mailed on October 14, 2009 (hereinafter, "final Office Action").

V. SUMMARY OF CLAIMED SUBJECT MATTER

The present invention is generally directed to automatically generating and serving a type of electronic advertisement (*i.e.*, an aggregate creative). A plurality of advertisements are assembled according to a definition for the type of electronic advertisement. The assembly of the plurality of advertisements includes rotating through a plurality of sub-advertisements (*i.e.*, subcreatives) and selecting subsets of sub-advertisements. Each subset of sub-advertisements includes a different combination of sub-advertisements and is included in one assembled advertisement. The plurality of advertisements (*i.e.*, aggregate creative forms) are stored after assembly. When an advertising system selects the type of electronic

advertisement for transmission to users on an electronic network, one of the plurality of stored assembled advertisements is selected and retrieved for transmission.

Independent claim 46 of the present application recites a method for automated generation and serving of aggregate creatives. The method comprises receiving an aggregate creative definition, the aggregate creative definition being associated with an aggregate creative that is selectable by an advertising system. (*See, e.g.*, present Specification as filed (hereinafter, “filed Specification”), page 8, lines 8-13; page 8, line 30-page 9, line 4; page 10, lines 6-12; page 11, lines 5-7, 13-17, 28-30; page 12, lines 6-20; page 13, lines 21-25; page 14, lines 1-3; page 17, line 28-page 18, line 2; page 18, lines 15-16; *see also* element 60 of FIG. 3; elements 62, 64 of FIG. 4; element 82 of FIG. 5; element 121 of FIG. 7.) The method also comprises selecting, in accordance with the aggregate creative definition, at least one set of more than one subcreative from a plurality of subcreatives in the advertising system. (*See, e.g.*, filed Specification, page 8, lines 13-16; page 10, lines 24-26; page 11, lines 5-8, 13-18; 24-26; page 12, lines 19-27; page 13, lines 21-25; page 14, lines 3-5; *see also* elements 66, 68, 78 of FIG. 4; elements 92, 94 of FIG. 5; element 122 of FIG. 7.) The method further comprises assembling, in accordance with the aggregate creative definition, a plurality of aggregate creative forms. (*See, e.g.*, filed Specification, page 8, lines 20-23; page 10, lines 14-22; page 11, lines 8-9, 16-18; page 12, lines 24-28; page 12, line 30-page 13, line 4; page 13, lines 25-26; page 14, lines 13-17; *see also* element 80 of FIG. 3; element 96 of FIG. 5; elements 80, 126A, 126B, 126C of FIG. 7.) Assembling a plurality of aggregate creative forms comprises rotating through the at least one set of more than one subcreative. (*See, e.g.*, filed Specification, page 14, lines 19-25; page 15, line 24-page 16, line 20; *see also* FIG. 7.) Assembling a plurality of aggregate creative forms also comprises selecting, during the step of rotating, a plurality of subsets of subcreatives to be included in the plurality of aggregate creative forms. (*See, e.g.*, filed Specification, page 14, lines 19-25; page 15, line 24-page 16,

line 20; *see also* FIG. 7.) The plurality of subsets of subcreatives includes different combinations of more than one subcreative. (*See, e.g.*, filed Specification, page 8, lines 20-23; page 10, lines 14-22, 27-28; page 13, lines 25-26; page 14, lines 19-29; page 16, lines 1-20; *see also* elements 41A, 41B of FIG. 2; elements 126A, 126B, 126C of FIG. 7.) The method additionally comprises storing the plurality of aggregate creative forms, the plurality of aggregate creative forms associated with the aggregate creative in the advertising system as assembled forms. (*See, e.g.*, filed Specification, page 12, line 19-28; *see also* element 98 of FIG. 5.) The method also comprises when the aggregate creative is selected for transmission to users on an electronic network by the advertising system, selecting one of the previously assembled plurality of stored aggregate creative forms associated with the aggregate creative, and retrieving the selected aggregate creative form for the transmission. (*See, e.g.*, filed Specification, page 8, lines 23-24; page 9, lines 12-16; page 9, line 30-page 10, line 4; page 10, lines 27-28; page 11, lines 9-11; page 13, lines 6-15, 28-30; *see also* FIG. 1; elements 102, 108, 110 of FIG. 6.)

Independent claim 63 of the present application recites a system for the automated generation and serving of aggregate creatives. The system recites means for the receiving an aggregate creative definition, using a computer processor, the aggregate creative definition being associated with an aggregate creative that is selectable by an advertising computer system. (*See, e.g.*, filed Specification, page 8, lines 8-13; page 8, line 30-page 9, line 4; page 9, lines 12-23; page 10, lines 6-12; page 11, lines 5-7, 13-17, 28-30; page 12, lines 6-20; page 13, lines 21-25; page 14, lines 1-3; page 17, line 28-page 18, line 2; page 18, lines 15-16; *see also* element 26 of FIG. 1; element 60 of FIG. 3; elements 62, 64 of FIG. 4; element 82 of FIG. 5; element 121 of FIG. 7.) The system also comprises means for selecting, in accordance with the aggregate creative definition, using a computer processor, at least one set of more than one subcreative from a plurality of subcreatives in the advertising computer

system. (*See, e.g.*, filed Specification, page 8, lines 13-16; page 9, lines 12-23; page 10, lines 24-26; page 11, lines 5-8, 13-18; 24-26; page 12, lines 19-27; page 13, lines 21-25; page 14, lines 3-5; *see also* element 26 of FIG. 1; elements 66, 68, 78 of FIG. 4; elements 92, 94 of FIG. 5; element 122 of FIG. 7.) The system further comprises means for assembling, in accordance with the aggregate creative definition, using a computer processor, a plurality of aggregate creative forms. (*See, e.g.*, filed Specification, page 8, lines 20-23; page 9, lines 12-23; page 10, lines 14-22; page 11, lines 8-9, 16-18; page 12, lines 24-28; page 12, line 30- page 13, line 4; page 13, lines 25-26; page 14, lines 13-17; *see also* element 26 of FIG. 1; element 80 of FIG. 3; element 96 of FIG. 5; elements 80, 126A, 126B, 126C of FIG. 7.) The means for assembling comprises means for rotating through the at least one set of more than one subcreative. (*See, e.g.*, filed Specification, page 14, lines 19-25; page 15, line 24-page 16, line 20; *see also* FIG. 7.) The means for assembling also comprises means for selecting, during the step of rotating, a plurality of subsets of subcreatives to be included in the plurality of aggregate creative forms. (*See, e.g.*, filed Specification, page 14, lines 19-25; page 15, line 24-page 16, line 20; *see also* FIG. 7.) The plurality of subsets of subcreatives includes different combinations of more than one subcreative. (*See, e.g.*, filed Specification, page 8, lines 20-23; page 10, lines 14-22, 27-28; page 13, lines 25-26; page 14, lines 19-29; page 16, lines 1-20; *see also* elements 41A, 41B of FIG. 2; elements 126A, 126B, 126C of FIG. 7.) The system additionally comprises means for storing the plurality of aggregate creative forms, the plurality of aggregate creative forms associated with the aggregate creative in the advertising computer system. (*See, e.g.*, filed Specification, page 9, lines 12-25; page 12, line 19-28; *see also* element 28 of FIG. 1; element 98 of FIG. 5.) The system also comprises means for selecting, using a computer processor, one of the plurality of stored aggregate creative forms associated with the aggregate creative, when the aggregate creative is selected for transmission to users on an electronic network by the advertising computer system as

assembled forms. (*See, e.g.*, filed Specification, page 8, lines 23-24; page 9, lines 12-23; page 9, line 30-page 10, line 4; page 10, lines 27-28; page 11, lines 9-11; page 13, lines 6-15, 28-30; *see also* element 26 of FIG. 1; elements 102, 108, 110 of FIG. 6.) The system further comprises means for retrieving, using a computer processor, the previously assembled selected aggregate creative form for transmission to users on an electronic network, when the aggregate creative is selected for the transmission to users on the electronic network by the advertising computer system. (*See, e.g.*, filed Specification, page 8, lines 23-24; page 9, lines 12-23; page 9, line 30-page 10, line 4; page 10, lines 27-28; page 11, lines 9-11; page 13, lines 6-15, 28-30; *see also* element 26 of FIG. 1; elements 102, 108, 110 of FIG. 6.)

Independent claim 80 of the present application recites a program product comprising a computer-readable storage device containing instructions recorded thereon, operable on a computer for the automated generation and serving of aggregate creatives. (*See, e.g.*, present Specification as amended in the Appellants' Response filed on October 23, 2008 (Exhibit A; hereinafter, "amended Specification"), replacement paragraph on page 9, starting at line 21; *see also* original claim 16.) The instructions are operable to be executed by the computer to perform the step of receiving an aggregate creative definition, the aggregate creative definition being associated with an aggregate creative that is selectable by an advertising system. (*See, e.g.*, filed Specification, page 8, lines 8-13; page 8, line 30-page 9, line 4; page 10, lines 6-12; page 11, lines 5-7, 13-17, 28-30; page 12, lines 6-20; page 13, lines 21-25; page 14, lines 1-3; page 17, line 28-page 18, line 2; page 18, lines 15-16; *see also* element 60 of FIG. 3; elements 62, 64 of FIG. 4; element 82 of FIG. 5; element 121 of FIG. 7.) The instructions are also operable to be executed by the computer to perform the step of selecting, in accordance with the aggregate creative definition, at least one set of more than one subcreative from a plurality of subcreatives in the advertising system. (*See, e.g.*, filed Specification, page 8, lines 13-16; page 10, lines 24-26; page 11, lines 5-8, 13-18; 24-26;

page 12, lines 19-27; page 13, lines 21-25; page 14, lines 3-5; *see also* elements 66, 68, 78 of FIG. 4; elements 92, 94 of FIG. 5; element 122 of FIG. 7.) The instructions are further operable to be executed by the computer to perform the step of assembling, in accordance with the aggregate creative definition, a plurality of aggregate creative forms. (*See, e.g.*, filed Specification, page 8, lines 20-23; page 10, lines 14-22; page 11, lines 8-9, 16-18; page 12, lines 24-28; page 12, line 30-page 13, line 4; page 13, lines 25-26; page 14, lines 13-17; *see also* element 80 of FIG. 3; element 96 of FIG. 5; elements 80, 126A, 126B, 126C of FIG. 7.) The step of assembling a plurality of aggregate creative forms comprises rotating through the at least one set of more than one subcreative. (*See, e.g.*, filed Specification, page 14, lines 19-25; page 15, line 24-page 16, line 20; *see also* FIG. 7.) The step of assembling a plurality of aggregate creative forms also comprises selecting, during the step of rotating, a plurality of subsets of subcreatives to be included in the plurality of aggregate creative forms. (*See, e.g.*, filed Specification, page 14, lines 19-25; page 15, line 24-page 16, line 20; *see also* FIG. 7.) The plurality of subsets of subcreatives include different combinations of more than one subcreative. (*See, e.g.*, filed Specification, page 8, lines 20-23; page 10, lines 14-22, 27-28; page 13, lines 25-26; page 14, lines 19-29; page 16, lines 1-20; *see also* elements 41A, 41B of FIG. 2; elements 126A, 126B, 126C of FIG. 7.) The instructions are additionally operable to be executed by the computer to perform the step of storing the plurality of aggregate creative forms, the plurality of aggregate creative forms associated with the aggregate creative in the advertising system as assembled forms. (*See, e.g.*, filed Specification, page 12, line 19-28; *see also* element 98 of FIG. 5.) The instructions are also operable to be executed by the computer to perform the steps of when the aggregate creative is selected for transmission to users on an electronic network by the advertising system, selecting one of the previously assembled plurality of stored aggregate creative forms associated with the aggregate creative, and retrieving the selected aggregate creative form for the transmission.

(*See, e.g.*, filed Specification, page 8, lines 23-24; page 9, lines 12-16; page 9, line 30-page 10, line 4; page 10, lines 27-28; page 11, lines 9-11; page 13, lines 6-15, 28-30; *see also* FIG. 1; elements 102, 108, 110 of FIG. 6.)

As the present Specification summarizes, “[t]here has thus been provided new and improved methods and systems for generating aggregate creatives having scaling benefits as compared to the manual creation of aggregate creatives, and run-time performance benefits as compared to a solution built with the associated creative feature.” (filed Specification, page 19, lines 4-7.)

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection to be reviewed on appeal are as follows:

Claims 63-96 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

Claims 46, 49-52, 54, 55, 59-63, 66-69, 71, 72, 76-80, 83-86, 88, 89, and 93-96 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0036654 to Evans *et al.* (hereinafter, “Evans”) in view of the article entitled “Adcycle Support: Getting Started,” pages 1-2 (hereinafter, “AdCycle”).

Claims 47-48, 56, 64-65, 73, 81-82, and 90 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Evans in view of AdCycle and in further view of U.S. Patent Application Publication No. 2002/0147645 to Alao *et al.* (hereinafter, “Alao”).

Claims 53, 58, 70, 75, 87, and 92 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Evans in view of AdCycle and in further view of U.S. Patent Application Publication No. 2002/0188635 to Larson *et al.* (hereinafter, “Larson”).

Claims 57, 74, and 91 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Evans in view of AdCycle and in further view of U.S. Patent Application Publication No. 2003/0191693 to Aphek (hereinafter, “Aphek”).

VII. ARGUMENTS

A. The rejection of claims 63-96 under 35 U.S.C. § 101 should be REVERSED, because the claim is directed to statutory subject matter.

Claims 63-96 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. (*See* final Office Action, page 3, line 1-page 4, line 12.) According to the final Office Action, “[c]laims 63-96 lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 101.” (*Id.*, page 16, lines 16-17.)

1. Claim 63 recites a computer processor which provides sufficient physical structure to constitute statutory subject matter within the meaning of 35 U.S.C. § 101.

Independent claim 63 provides sufficient physical structure to constitute statutory subject matter within the meaning of 35 U.S.C. § 101, because claim 63 recites elements “using a computer processor.”

According to the final Office Action:

Claims 63-79 disclose a computer processor; the claims and the specification fail to disclose if the “computer processor” indicates any hardware. Therefore, the “computer processor” may be a software processor; thus, representing a data structure and not hardware. In addition, the use of the word “system” does not inherently mean that claim is directed to a physical machine.”

(final Office Action, page 4, lines 1-5; page 16, lines 17-21.) Contrary to the final Office Action’s assertion, however, the present Specification defines the claimed computer processor as computer hardware. In particular, the present Specification explains that

“[a]dvertising system processor 26 comprises *any conventional computer, for example a personal computer, server or mainframe*, capable of performing the processes of the present invention.” (filed Specification, page 9, lines 21-23.) In other words, the present Specification defines the claimed computer processor to be a conventional computer, which is equated with hardware devices such as a personal computer or a mainframe. *Id.*

For example, a “personal computer” means:

A system, containing a host and a limited number of peripherals designed to be used in the home or in small offices, that enables individuals to perform a variety of computing or word-processing functions or both, and that typically is of *a size permitting it and its peripherals to be located on a table surface*.

IEEE 100 The Authoritative Dictionary of IEEE Standards Terms (7th Ed. 2000) (Exhibit B) (emphasis added). In addition, a “mainframe computer” means “[a] computer employing one or more mainframes [such as IBM’s 3090],” and correspondingly a “mainframe” means “*the cabinet that houses* the central computer and main storage of a computer system.” *Id.* (Exhibit C) (emphasis added). A personal computer is characterized by its physical size, while a mainframe is characterized by the use of a physical cabinet. *Id.* (Exhibits B and C). Thus, as a conventional computer, the claimed computer processor includes the physical structure associated, for example, with a personal computer and a mainframe. The claimed computer processor cannot be a software processor or a data structure as asserted by the final Office Action.

According to the *Manual of Patent Examination Procedure (M.P.E.P.)*, “[w]here an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim.” *M.P.E.P.* § 2111.01 IV. (citing *Toro Co. v. White Consolidated Indus. Inc.*, 199 F.3d 1295, 1301 (Fed. Cir. 1999)). Therefore, the interpretation of computer processor in the claims must be consistent with the definition provided in the present Specification. Moreover, the *M.P.E.P.* explains that “the meaning of

a particular claim term may be defined by implication, that is, according to the usage of the term in the context in the specification.” *Id.* (citing *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) and *Vitronics Corp. v. Conceptiontronic Inc.*, 90 F.3d 1576, 1583 (Fed. Cir. 1996)). Accordingly, the meaning of computer processor in the claims must be construed according to its usage in the present Specification. In particular, the term is used in the context of hardware devices, such as a personal computer or a mainframe. (*See* filed Specification, page 9, lines 21-23.)

Applicants respectfully submit that the computer processor recited by independent claim 63 provides sufficient physical structure to constitute a statutory manufacture or machine within the meaning of 35 U.S.C. § 101.

2. Claim 63 recites elements in means plus function format which read on the structures or materials disclosed in the present Specification, and the present Specification provides sufficient structure for the claims to constitute statutory subject matter within the meaning of 35 U.S.C. § 101.

Independent claim 63 is directed to a system comprising elements written in means plus function format according to 35 U.S.C. § 112, paragraph 6. These elements read on the structures or materials disclosed in the present Specification, and the present Specification provides sufficient structure for the claims to constitute statutory subject matter within the meaning of 35 U.S.C. § 101.

According to the *M.P.E.P.*, “[w]here means plus function language is used to define the characteristics of a machine or manufacture invention, such language must be interpreted to read on only *the structures or materials disclosed in the specification* and ‘equivalents thereof’ that correspond to the recited function.” *M.P.E.P.*, § 2106 II.C. (emphasis added). Therefore, the structures corresponding to the elements written in means plus function format can be found in the present Specification. According to the present Specification:

Advertising system processor 26 comprises any conventional computer, for example a personal computer, server or mainframe, capable of performing the functions described below. Similarly, advertising database 28 comprises any conventional storage system for storing the data described below as well as software for performing the processes of the present invention. Embodiments include a program product comprising a storage device containing instructions operable on a computer for automated generation of aggregate creatives, the instructions operable with the computer to perform the processes of the present invention. Firewall 32 and web server 34 are conventional components known to those skilled in the art, the firewall providing network communications security and the web server providing a non-secure interface between client-side system 24 and server-side system 22.

(amended Specification (Exhibit A), replacement paragraph on page 9, starting at line 21.)

Accordingly, the structure in the present Specification for the means plus function elements recited in claim 63 includes “any conventional computer, for example a personal computer, server or mainframe, capable of performing the functions described” *Id.* As described above, computer devices such as a personal computer or a mainframe are hardware devices with sufficient physical structure to constitute a statutory manufacture or machine within the meaning of 35 U.S.C. § 101. In particular, according to their definitions, a personal computer is characterized by its physical size, while a mainframe is characterized by the use of a physical cabinet. *See IEEE 100 The Authoritative Dictionary of IEEE Standards Terms* (7th Ed. 2000) (Exhibits B and C). The means plus function elements include the structure of a personal computer and a mainframe, for example.

In addition, the structure in the present Specification for the means recited in claim 63 also includes “a program product comprising a storage device containing instructions operable on a computer for automated generation of aggregate creatives, the instructions operable with the computer to perform the processes of the present invention.” (amended Specification, replacement paragraph on page 9, starting at line 21.) According to the *M.P.E.P.*, “a claimed computer-readable medium encoded with a computer program” is statutory. *M.P.E.P.*, § 2105. The storage device described in the present specification

corresponds with the “claimed computer-readable medium” described by the *M.P.E.P.* The storage device described in the specification includes hardware based at least on its ability to act as a medium on which instructions can be stored and accessed by computer hardware and their ability to act with the computer hardware to cause the instructions to be physically realized.

According to the *M.P.E.P.*, to determine the broadest reasonable interpretation of a claim, “the words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification.” *M.P.E.P.*, § 2111.01 (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989); *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1372 (Fed. Cir. 2004)). Correspondingly, a “storage device” means: “A device in which data can be stored and from which it can be copied at a later time. The means of storing data may be chemical, electrical, mechanical, etc.” *IEEE 100 The Authoritative Dictionary of IEEE Standards Terms* (7th Ed. 2000) (Exhibit D). As such, the plain meaning of a storage device requires a physical, *i.e.*, “chemical, electrical, mechanical, etc.,” means of storing data. Correspondingly, a “storage” means “[a]ny medium in which data can be retained.” *Id.* Thus, the storage device described in the present Specification clearly corresponds with the “claimed computer-readable medium” described by the *M.P.E.P.* See *M.P.E.P.*, § 2105.

Moreover, as explained previously, the disclosure of a conventional computer such as a personal computer or mainframe provides physical structure to claim 63. As is known, personal computers and mainframes include hardware relating to data and software storage. For example, a mainframe means “the cabinet that houses the central computer and **main storage** of a computer system.” See *IEEE 100 The Authoritative Dictionary of IEEE Standards Terms* (7th Ed. 2000) (Exhibit C). According to this definition, main storage in a mainframe is hardware, because it is capable of being housed in a cabinet. Thus, the means

plus function elements include at least the structure of the storage hardware associated with a conventional computer such as a mainframe.

Furthermore, the specification indicates that the storage device includes hardware when it explains that the storage device is a part of “a program product.” According to the *M.P.E.P.*, “[p]roduct claims are claims that are directed to either machines, manufactures or compositions of matter.” *M.P.E.P.* § 2106 I. C. Indeed, the *M.P.E.P.* associates a claimed product with physical structure in the present context when it states: “When a computer program is recited in conjunction with a physical structure, such as a computer memory, USPTO personnel should treat the claim as a product claim.” *M.P.E.P.* § 2106.01 I.

Appellants respectfully submit that, according to 35 U.S.C. § 112, paragraph 6, the physical structure disclosed in the present Specification is incorporated into the means plus function elements in independent claim 63. As such, claim 63 includes sufficient physical structure to constitute a statutory manufacture or machine within the meaning of 35 U.S.C. § 101.

3. Claim 80 recites a computer-readable storage device which provides sufficient physical structure to constitute statutory subject matter within the meaning of 35 U.S.C. § 101.

Appellants respectfully submit that independent claim 80 provides sufficient physical structure to constitute statutory subject matter within the meaning of 35 U.S.C. § 101, because the claim 80 is directed to a “a program product comprising a computer-readable storage device containing instructions recorded thereon, operable on a computer for the automated generation and serving of aggregate creatives, the instructions operable to be executed by the computer to perform the steps of”

According to the final Office Action:

Claims 80-96 disclose a computer-readable storage device; however, the claims and the specification fail to disclose if the “computer-readable storage device” indicates any hardware. Therefore, the “computer-readable storage device” may be a database, thus, representing a data structure and not hardware. The claims appear to be claiming “software systems” i.e. systems without hardware indication, which is a computer program per se. Since the claims disclose computer program per se that is not embodied on a computer readable medium, they appear non-statutory.

According to the *M.P.E.P.*, “a claimed computer-readable medium encoded with a computer program” is statutory. *M.P.E.P.*, § 2105. As described previously, the present Specification states:

Similarly, advertising database 28 comprises any conventional storage system for storing the data described below as well as software for performing the processes of the present invention. Embodiments include a program product comprising a storage device containing instructions operable on a computer for automated generation of aggregate creatives, the instructions operable with the computer to perform the processes of the present invention.

(amended Specification, replacement paragraph on page 9, starting at line 21.) The “storage device” described in the present Specification and recited in claim 80 corresponds with the “claimed computer-readable medium” described by the *M.P.E.P.* The storage device described in the specification includes hardware based at least on its ability to act as a medium on which instructions can be stored and accessed by computer hardware and their ability to act with the computer hardware to cause the instructions to be physically realized.

When discussing computer-related non-statutory subject matter, the *M.P.E.P.* reminds the Examiner, “In the final analysis under § 101, the claimed invention, *as a whole*, must be evaluated for what it is.” *Id.*, § 2106.01 (citing *In re Sarkar*, 588 F.2d 1330, 1333 (CCPA 1978)) (emphasis added). Moreover, according to present examination instructions, “the meaning of the claim as a whole must be determined using the ‘broadest reasonable interpretation’ standard, which requires that the claims be given their broadest reasonable interpretation consistent with the specification and consistent with the interpretation that those skilled in the art would reach.” See Memorandum from Andre H. Hirshfeld, Acting

Deputy Commissioner for Patent Examination Policy, to TC Directors, August 24, 2009, page 6, lines 34-38 (providing Interim Examination Instructions for Evaluating Subject Matter Eligibility under 35 U.S.C. § 101); *see also* *M.P.E.P.*, § 2111.01. According to the *M.P.E.P.*, to determine the broadest reasonable interpretation of a claim, “the words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification.” *M.P.E.P.*, § 2111.01 (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989); *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1372 (Fed. Cir. 2004)). As described previously, a “storage device” is defined as: “A device in which data can be stored and from which it can be copied at a later time. The means of storing data may be chemical, electrical, mechanical, etc.” *IEEE 100 The Authoritative Dictionary of IEEE Standards Terms* (7th Ed. 2000) (Exhibit D). As such, the plain meaning of a storage device requires a physical, *i.e.*, “chemical, electrical, mechanical, etc.,” means of storing data. Correspondingly, “storage” means “[a]ny medium in which data can be retained.” *Id.* Thus, the storage device described in the present Specification and recited in claim 80 clearly corresponds with the “claimed computer-readable medium” described by the *M.P.E.P.* *See* *M.P.E.P.*, § 2105. Moreover, in contrast to the recorded instructions which are “executed by the computer,” the computer-readable storage device is “operated on a computer.” Taking the claim as a whole, the computer-readable storage device relates to the computer in a manner that is different from data structures such as executable instructions, *i.e.*, a computer program.

Furthermore, the specification indicates that the storage device includes hardware when it explains that the storage device is a part of “a program product.” According to the *M.P.E.P.*, “[p]roduct claims are claims that are directed to either machines, manufactures or compositions of matter.” *M.P.E.P.* § 2106 I. C. Indeed, the *M.P.E.P.* associates a claimed product with physical structure in the present context when it states: “When a computer

program is recited in conjunction with a physical structure, such as a computer memory, USPTO personnel should treat the claim as a product claim.” *M.P.E.P.* § 2106.01 I.

Appellants respectfully submit that the computer-readable storage device recited by independent claim 80 provides sufficient physical structure to constitute a statutory manufacture or machine within the meaning of 35 U.S.C. § 101.

In view of the structure clearly recited in claims 63 and 80, Appellants respectfully submit that claims 63-96 comply with the requirements under 35 U.S.C. § 101 and are statutory. Appellants also respectfully submit that dependent claims 64-79 and 81-96 include sufficient structure at least for the same reasons as their respective base claims 63 and 80. Accordingly, Appellants respectfully request that the rejection of claim 63-96 under 35 U.S.C. § 101 be **REVERSED**.

B. The rejection of claims 46, 49-52, 54, 55, 59-63, 66-69, 71, 72, 76-80, 83-86, 88, 89, and 93-96 under 35 U.S.C. § 103(a) should be REVERSED, because Evans and AdCycle fail to provide sufficient grounds for establishing a case of obviousness.

Claims 46, 49-52, 54, 55, 59-63, 66-69, 71, 72, 76-80, 83-86, 88, 89, and 93-96 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Evans in view of AdCycle. (*See* final Office Action, page 4, lines 21-24.) Appellants respectfully request that the rejection of the claims under 35 U.S.C. § 103(a) be **REVERSED**, because Evans and AdCycle, alone or in combination, fail to provide sufficient evidence for establishing a case of obviousness against the claims.

1. Evans and AdCycle, alone or in combination, fail to teach or suggest each and every element recited by the claims.

One basic requirement for a *prima facie* case of obviousness under 35 U.S.C. § 103(a) is that the prior art references must teach or suggest each and every element recited by the

claims. *See generally M.P.E.P.* § 2143. “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *M.P.E.P.* § 2143.03 (citing *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)). Appellants respectfully request that the rejection of the claims under 35 U.S.C. § 103(a) be **REVERSED**, because Evans and AdCycle fail to teach or suggest each and every element recited by independent claims 46, 63, and 80.

According to the present Specification, an aggregate creative is “one type of electronic advertisement in which multiple advertisements appear together in one or more groups.” (filed Specification, page 8, lines 9-10.) Meanwhile, a subcreative is “an individual advertising message that is a member of an aggregate creative.” (*Id.*, page 8, lines 13-14.) Furthermore, “[a]n aggregate creative form,’ or ‘form,’ is a single snapshot of an aggregate creative which has a particular set and order of displayed subcreatives.” (*Id.*, page 8, lines 20-21.) To illustrate these concepts in an example, an aggregate creative may be an online advertisement that appears on a webpage with a different combination of sub-advertisements (subcreatives) each time the webpage is accessed, and an aggregate creative form refers to a specific appearance of the advertisement with a specific assembly of sub-advertisements (subset of subcreatives) when the webpage is accessed on a single occasion.

The present Specification explains that “the present invention provides for the creation of multiple aggregate creative forms with different sets and/or orders of subcreatives.” (*Id.*, page 8, lines 21-23.) Aggregate creative forms can be assembled by selecting subsets of more than one subcreative to be included in the aggregate creative forms. (*See id.*, page 12, line 24-page 13, line 1.) Moreover, the present Specification explains that rotation algorithms may be employed as a technique for traversing a set of subcreatives and selecting the subsets of subcreatives to be assembled into the aggregate creative forms. (*See id.*, page 15, line 24-page 16, line 20.)

The present Specification also explains that the plurality of aggregate creative forms are stored after assembly. (*See id.*, page 12, line 28.) According to the present Specification:

With reference to Figure 6, the process 100 for serving creatives is shown to include the step of receiving a request to serve an ad (step 102) into an advertising system processor 26 from web server 34. . . . If the creative is an aggregate creative (step 106), an appropriate form of the aggregate creative is chosen (step 110) and is transmitted in accordance with the advertising system direction (step 108). With reference to step 110, it will be understood that this step is a modification of most standard advertising systems in accordance with the present invention, adding a layer of abstraction beyond a standard advertising creative.

(*Id.*, page 13, lines 6-15.) Thus, the plurality of aggregate creative forms are first generated and stored offline with respect to an advertising system. *Id.* One of the previously assembled plurality of stored aggregate creative forms is subsequently retrieved for transmission to users on an electronic network by the advertising system when the corresponding aggregate creative is selected for transmission. *Id.*

According to the present Specification:

Currently, without the benefit of the present invention and using one of the methods above, it is necessary to create each form of a creative manually – a very time- and labor-intensive process. In accordance with the invention, the aggregate creative definition is interpreted automatically by an assembly process to generate a very large number of creative forms in a very short period of time. It will thus be seen that one advantage of the present invention over prior art, manual methods for assembling creatives, is the ability to automatically generate large numbers of aggregate create forms from predetermined sets of data. Further, the aggregate creative forms can be regenerated off-line from the actual advertising serving as frequently as desired, for example to reorder the subcreatives, without negatively affecting the on-line system's performance.

(filed Specification, page 14, line 29-page 15, line 8).

Independent claim 46 of the present application recites a method for automated generation and serving of aggregate creatives. Independent claim 63 of the present application recites a system for the automated generation and serving of aggregate creatives. Independent claim 80 of the present application recites a program product comprising a

computer-readable storage device containing instructions recorded thereon, operable on a computer for the automated generation and serving of aggregate creatives.

Independent claim 46 recites, *inter alia*:

assembling, in accordance with the aggregate creative definition, a plurality of aggregate creative forms, comprising the steps of:

rotating through the at least one set of more than one subcreative; and

selecting, during the step of rotating, a plurality of subsets of subcreatives to be included in the plurality of aggregate creative forms, the plurality of subsets of subcreatives including different combinations of more than one subcreative;

storing the plurality of aggregate creative forms, the plurality of aggregate creative forms associated with the aggregate creative in the advertising system as assembled forms; and

when the aggregate creative is selected for transmission to users on an electronic network by the advertising system, selecting one of the previously assembled plurality of stored aggregate creative forms associated with the aggregate creative, and retrieving the selected aggregate creative form for the transmission.

Independent claim 63 recites, *inter alia*:

means for assembling, in accordance with the aggregate creative definition, using a computer processor, a plurality of aggregate creative forms, the means for assembling comprising:

means for rotating through the at least one set of more than one subcreative; and

means for selecting, during the step of rotating, a plurality of subsets of subcreatives to be included in the plurality of aggregate creative forms, the plurality of subsets of subcreatives including different combinations of more than one subcreative;

means for storing the plurality of aggregate creative forms, the plurality of aggregate creative forms associated with the aggregate creative in the advertising computer system;

means for selecting, using a computer processor, one of the plurality of stored aggregate creative forms associated with the aggregate creative, when the aggregate creative is selected for transmission to users on an electronic network by the advertising computer system as assembled forms; and

means for retrieving, using a computer processor, the previously assembled selected aggregate creative form for transmission to users on an electronic network, when the aggregate creative is selected for the transmission to users on the electronic network by the advertising computer system.

Independent claim 80 recites, *inter alia*:

assembling, in accordance with the aggregate creative definition, a plurality of aggregate creative forms

comprising the steps of:

rotating through the at least one set of more than one subcreative; and

selecting, during the step of rotating, a plurality of subsets of subcreatives to be included in the plurality of aggregate creative forms, the plurality of subsets of subcreatives including different combinations of more than one subcreative;

storing the plurality of aggregate creative forms, the plurality of aggregate creative forms associated with the aggregate creative in the advertising system as assembled forms;

storing the plurality of aggregate creative forms, the plurality of aggregate creative forms associated with the aggregate creative in the advertising system as assembled forms; and

when the aggregate creative is selected for transmission to users on an electronic network by the advertising system, selecting one of the previously assembled plurality of stored aggregate creative forms associated with the aggregate creative, and retrieving the selected aggregate creative form for the transmission.

Thus, claims 46, 63, and 80 require assembling a plurality of aggregate creative forms associated with an aggregate creative, storing the assembled plurality of aggregate creative forms, and selecting and retrieving one of the previously assembled plurality of stored aggregate creative forms when the aggregate creative is selected for transmission to users on an electronic network by an advertising system.

Contrary to the claimed invention, Evans fails to teach or suggest assembling a plurality of advertisements by rotating through at least one set of subcreatives and selecting subsets of more than one subcreative during the rotation, where the subsets include different

combinations of more than one subcreative. Rather than assembling a plurality of aggregate creative forms, the system of Evans is directed toward a user-driven process for creating a single layout of product references in a single advertisement. *See, e.g.*, Evans, paragraphs [0048] and [0051]-[0052]. For example, with reference to FIG. 3, Evans states:

In step 302, advertising formats are displayed for the user. In step 304, the user selects an advertising format to sue. In step 306, at least one template corresponding to the selected advertising format may be displayed. In step 308, at least one product reference is displayed for the user. In step 310, the user selects at least one product reference. In step 312, the selected product reference may be displayed on the template. In step 314, a preview of the advertisement may be created for the user. In step 316, the user may review the preview, and, if satisfactory, may authorize the production of the advertisement. In step 318, the advertisement may be produced, in an electronic format, in a printed format, etc.

Id., paragraph [0048]. Steps 302 through 316 produce just *one* advertisement for subsequent production in step 318. Nowhere does Evans disclose that a plurality of advertisements are assembled as recited by the claims. Furthermore, steps 304, 310, and 316 require action and/or input from the user. A process which requires such manual interaction by the user is clearly more suitable for the generation of a single advertisement, rather than a plurality of advertisements. As such, the manual process of Evans fails to even contemplate generating and storing a plurality of aggregate creative forms.

According to the final Office Action:

Each template may contain multiple ad areas (Paragraph 0069) which each ad area able to contain more than one product references (Paragraph 0068, Page 6, lines 5-14; Paragraph 0071. Therefore, Paragraph 0088, Paragraph 0095: Discloses one embodiment wherein a template and a list of product references are submitted to a assistance layout program that lays out the product references into the template. Here, the computer would read the list of product references, select the product reference, obtain the product reference and place it into template based on the instructions of either priority based or order-based from the list. Each product being advertised has multiple product references from which the assistance layout may choose. Since the program has multiple product references to choose from, it provides greater flexibility creating multiple advertisements. Thus a process of creating a computer-created advertisement, hence using a computer that is used to create ads using an automated

assembly. Furthermore, it is implicitly known if the Evans et al.'s method is capable of performing the functionality once, then it may generate the same functionality over again. Thus multiple computer-created advertisements have the functionality to be generated.

(Office Action, p. 5, line 22-page 6, line 17.) Contrary to the assertions in the final Office Action, Evans does not expressly disclose the assembly of a plurality of advertisements. Evans merely describes creating a single advertisement, where product references of different sizes are available for each product to facilitate the layout of product references in the single advertisement. *See* Evans, paragraphs [0088] and [0095]. Indeed, multiple product references are employed in order to enable the creation of an *optimal*, i.e., single, advertisement according to a predefined set of priorities. *See id.*

Because Evans does not expressly disclose the assembly of a plurality of advertisements, Evans also fails to disclose storing a plurality of assembled advertisements, as required by the claims. Moreover, Evans fails to disclose selecting and retrieving one of the previously stored plurality of assembled advertisements when the type of advertisement is selected for transmission to users on an electronic network by an advertising system.

The Examiner asserts that "it is implicitly known if the Evans et al.'s method is capable of performing the functionality once, then it may generate the same functionality over again." (Office Action, p. 6, lines 14-16.) As the goal of Evans is to enable the creation of an optimal advertisement, the repeated execution of Evans would merely produce the same advertisement over and over again, contrary to the claims 46, 63, and 80, which require that the plurality of aggregate creative forms include "different combinations of more than one subcreative."

Moreover, Evans fails to disclose rotating through the product references and selecting subsets of product references to assemble a plurality of advertisements, as required by the claims. Indeed, the final Office Action acknowledges:

. . . Evans et al. fails to specifically disclose rotating through at least one set of more than one subcreative; and selecting, during the step of rotating, a plurality of subsets of subcreatives to be included in the plurality of aggregate creative forms, the plurality of subsets including different combinations of more than one subcreative.

(final Office Action, page 7, lines 14-18.) Because Evans fails to disclose rotating through at least one set of subcreatives and selecting subsets of more than one subcreative during the rotation, Evans fails to teach or suggest generating a plurality of advertisements in a manner that is as effective as the claimed invention. Indeed, the present Specification contrasts the claimed invention from the inefficient process of generating a plurality of advertisements according to the teachings of Evans as suggested by the final Office Action. The present Specification explains “that one advantage of the present invention over prior art, manual methods for assembling creatives, is the ability to automatically generate large numbers of aggregate forms from predetermined sets of data.” (filed Specification, page 14, line 31-page 15, line 5.) Because it is difficult to generate a plurality of advertisements according to the teachings of Evans, Evans fails to contemplate any process that would generate such a plurality of advertisements for storage and subsequent use by an advertising system, as required by the claimed invention.

According to the final Office Action:

Paragraph 0048, Step 314 Claim 1, 16, 39: Discloses the creation/generation of a proposed advertisement that is used to be displayed to the user for authorization. The generation of proposed advertisement is defined as the plurality of product references that has been laid out on the plurality of advertisement areas. Thus, when displaying the proposed advertisement to the user, an “assembled form” is presented. In addition, it is inherently known when any data (i.e. advertisement) is created, its stored in a form of memory such as a memory buffer or in a volatile memory for further operations (i.e. displayed). Furthermore, after authorization/approval, the proposed (assembled) advertisement may be transmitted to users via a printer, email or posted on a web site by Internet. (Paragraphs 0052, 0095, Claim 17)

(final Office Action, page 7, lines 2-13). The final Office Action relies on the sections of Evans which teach the display of a single advertisement or the transmission of a single

advertisement by printer, email, or on a web site. Assuming *arguendo* that the single advertisement is inherently stored with these teachings, Evans still fails to disclose that a **plurality** of advertisements are stored after assembly and that **one** of these assembled advertisements is subsequently selected and retrieved for transmission by an advertising system.

Moreover, Evans fails to disclose that an advertisement is retrieved from storage when the corresponding type of advertisement is selected for transmission to users on an electronic network by an advertising system. Indeed, as described previously, Evans does not expressly disclose the generation of a plurality of advertisements. As such, Evans fails to contemplate a plurality of advertisements corresponding to a type of advertisement. Furthermore, Evans does not contemplate the selection of one of the plurality of advertisements (*i.e.*, aggregate creative forms) in response to the selection of the corresponding type of advertisement (*i.e.*, aggregate creative), as required by the claims. By ignoring these aspects of the claimed invention, the final Office Action has failed to consider all the words in the claim and has improperly rejected the claims. *See M.P.E.P.* § 2143.03 (explaining, “All words in a claim must be considered in judging the patentability of that claim against the prior art.”). In sum, Evans fails to teach or suggest assembling a plurality of aggregate creative forms associated with an aggregate creative, storing the assembled plurality of aggregate creative forms, and selecting and retrieving one of the previously assembled plurality of stored aggregate creative forms when the aggregate creative is selected for transmission to users on an electronic network by an advertising system

As described previously, the final Office Action acknowledges that Evans fails to disclose rotating through at least one set of more than one subcreative and selecting, during the step of rotating, a plurality of subsets of subcreatives to be included in the plurality of aggregate creative forms” as required by claims 46, 63, and 80. To cure this deficiency in

Evans, the final Office Action attempts to modify the teachings of Evans with those in AdCycle. (*See* final Office Action, page 7, line 18-page 8, line 11.) In particular, the final Office Action asserts:

. . . Adcycle discloses the use of ad groups wherein each group contains multiple as campaigns (advertisement). The groups are regions on the web page wherein each group rotates the ads based on the ad campaigns in that group. For example, Adcycle disclose the user creating a group to be located on the top of the web page, wherein that group contains multiple ad campaigns, and rotates each ad campaign for each time the group is displayed. Thus, it is implicitly known if Adcycle's method is capable of performing the functionality once for one region, then it may generate another group for a different region. Therefore, Adcycle discloses the ability for multiple locations of ads on the webpage equaling the number of created groups at a time. Each time the groups on the webpage are displayed, a new ad is rotated for display. Thus, each time the web page is view, a different combination of ads are presented based on the rotation of the ads in each group. (Page 1-2)

It would have been obvious to one of ordinary skill in the art at the time of Application's invention to have modified Evan's advertisement creation method with Adcycle's feature of rotating ads since it would have provided the benefit of a fast and inexpensive method for advertisers that want to place only a limited number of ads.

Id.

AdCycle discloses the following:

After installing AdCycle, login to adcenter using the password and user name as listed in the AdConfig.pm file. Surf the admin area for a while to build familiarity with the functions available. The first step in creating an ad rotation is defining were you want the ads to rotate. Keeping things simple, let assume you wanted to rotate 468x60 pixel ads at the top of your webpages, a similar setup to the AdCycle site. So for a single rotation of 468x60 ads;

1. Click on the "Groups" tab on the top of the AdCycle admin window, and create one group called "Top of Webpages" and select the 468x60 ad type. After creating the group, the next step is to fill the group with a couple 468x60 campaigns.
2. Click the "Advertiser" tab at the top of the AdCycle admin window and create an advertiser called "Nike Inc."
3. Click on the "Campaigns" tab, and then create two 468x60 campaigns for advertiser "Nike Inc.", one called "Nike 1" and the other called "Nike 2".

4. On the “Campaigns” page, click on the “edit” link of campaign “Nike 1”, and add at least one 468x60 banner using the “Add a GIF” link in the campaign profile. Repeat this procedure for campaign “Nike 2”.

5. Next, click on the “Groups” tab, and edit the “Top of Webpages” group you created previously. You should see both the “Nike 1” and “Nike 2” campaigns. When selected, the campaigns within the group will rotate with the rotation scheme you choose.

6. Next, after verifying that each campaign is selected within the group, go back to the “Groups” page and click the “ad code” link for the “Top of Webpages” group.

7. Grab an ad code and paste it into your webpage HTML. View the page with a browser, and reload it a few times to see your banners appearing.

Congratulations!, you have just learned how to use AdCycle. It is recommended that you stay away from anything fancy until you have become comfortable using the basic functionality.

Things to remember;

- An advertiser is the person or company that is advertising on your site.

- An advertiser can have one or more campaigns. A campaign is a single ad buy from an advertiser. The campaign defines what ads will be delivered, the dates of delivery, the maximum impressions or clicks delivered etc. For example, you may run a campaign for Nike where they want to buy 1000 clicks on your site, from 12/1 to 12/30, using 10 different 468x60 banner ads. You would add Nike as an advertiser, then add the campaign for Nike with these parameters.

- Groups are regions in your page(s) where you would like to rotate ads. A group could be a 88x31 pixel button position on your homepage, or even a 120x60 cube on your travel pages.

- Groups can contain one or hundreds of campaigns. Each group has a unique ad code that when placed into a web page, will rotate the campaigns in the group.

AdCycle, “How do I create my first ad rotation?” Even if AdCycle discloses rotating through campaigns in a group to produce web pages with different combinations of campaigns, AdCycle is completely silent on assembling a plurality of aggregate creative forms associated with an aggregate creative, storing the assembled plurality of aggregate creative forms, and selecting and retrieving one of the previously assembled plurality of stored aggregate creative

forms when the aggregate creative is selected for transmission to users on an electronic network by an advertising system. (*See id.*) Rather than initially generating and storing a plurality of web pages with different combinations of campaigns, AdCycle indicates that web pages with different combinations of campaigns are generated at the time that they are called by a browser. In particular, steps 1-7 in AdCycle relate to “defining w[h]ere you want the ads to rotate” (AdCycle, lines 10-11) and the resulting rotation only appears when a user “view[s] the page with a browser, and reload[s] it a few times to see your banners appearing” (*id.*, lines 28-29). Because a web page is generated at the same time that it is transmitted to a browser, there is no need to store the generated web page for subsequent selection and transmission. Indeed, the purpose of AdCycle is to provide different web pages each time, so there is no need to store web pages that have already been transmitted to the browser. If a web page must inherently be stored temporarily to transmit it to a browser, storage of only a single web page would be required. In general, AdCycle is completely silent on what happens to the web pages after they have been served.

Because AdCycle fails to contemplate storing a plurality of assembled advertisements, AdCycle also fails to disclose that one assembled advertisement is selected and retrieved from a previously assembled plurality of stored advertisements previously for transmission by an advertising system, as required by the claims. Moreover, AdCycle fails to disclose that an advertisement is retrieved from storage when the corresponding type of advertisement is selected for transmission to users on an electronic network by an advertising system. In particular, AdCycle fails to contemplate a plurality of assembled advertisements corresponding to a type of advertisement. Thus, AdCycle does not contemplate the selection of one of the plurality of advertisements (*i.e.*, aggregate creative forms) in response to the selection of the corresponding type of advertisement (*i.e.*, aggregate creative), as required by the claims.

In view of the foregoing, Evans and AdCycle fail to teach or suggest assembling a plurality of aggregate creative forms associated with an aggregate creative, storing the assembled plurality of aggregate creative forms, and selecting and retrieving one of the previously assembled plurality of stored aggregate creative forms when the aggregate creative is selected for transmission to users on an electronic network by an advertising system, as required by independent claims 46, 63, and 80. Because Evans and AdCycle fail to teach or suggest each and every element recited by independent claims 46, 63, and 80, the rejection of the claims under 35 U.S.C. § 103(a) be should be **REVERSED**.

2. Evans and AdCycle cannot be combined as suggested by the final Office Action to achieve the claimed invention with a reasonable expectation of success or with at least some degree of predictability.

According to the *M.P.E.P.*, “The prior art can be modified or combined to reject claims as prima facie obvious as long as there is a reasonable expectation of success.” *M.P.E.P.* § 2143.02 I. Additionally, the *M.P.E.P.* explains that “at least some degree of predictability is required.” *Id.* § 2143.02 II. Appellants respectfully request that the rejection of the claims under 35 U.S.C. § 103(a) be **REVERSED**, because the teachings of Evans and AdCycle cannot be combined as suggested by the final Office Action to achieve the claimed invention with a reasonable expectation of success or with at least some degree of predictability.

As described previously, the final Office Action acknowledges that Evans fails to disclose rotating through at least one set of more than one subcreative and selecting, during the step of rotating, a plurality of subsets of subcreatives to be included in the plurality of aggregate creative forms” as required by independent claims 46, 63, and 80. To cure this deficiency in Evans, the final Office Action attempts to modify the teachings of Evans with those in AdCycle. (*See* final Office Action, page 7, line 18-page 8, line 11.) In particular, the

final Office Action explains: “It would have been obvious to one of ordinary skill in the art at the time of Application’s invention to have modified Evan’s advertisement creation method with Adcycle’s feature of rotating ads” (*Id.*, page 8, lines 8-11).

As also described previously, however, the web pages in AdCycle are generated at the time that they are transmitted to a browser requesting the page. As such, even if AdCycle discloses rotating through campaigns in a group to produce web pages with different combinations of campaigns, the rotation occurs at the time that the web page is transmitted. As AdCycle explains, the results of the rotation appear only when a user “view[s] the page with a browser, and reload[s] it a few times to see your banners appearing.” AdCycle, lines 28-29. According to Evans:

In another preferred embodiment, a user may specify the electronic delivery of a final or non-final advertisement to a target audience via e-mail or by posting it on one or more websites. This enables a user to produce both printed and electronic advertisements through the systems and methods of the invention.

Evans, paragraph [0052]. Thus, applying the teachings of AdCycle to Evans would actually require the rotation to occur at the time that the advertisement is posted to one or more websites. According to the final Office Action, the advertisement in Evans has already been assembled at the time that it is posted (*see* final Office Action, page 7, lines 6-7, 10-12). Therefore, the rotation taught by AdCycle cannot occur during assembly of the advertisement, as the final Office Action asserts (*see id.*, page 8, lines 8-11). A system which fails to use rotation during the assembly of a plurality of advertisements fails to resemble the claimed invention.

Moreover, as described previously, Evans does not expressly disclose the assembly of a plurality of advertisements. Because Evans provides only one assembled advertisement at the time of posting to a website and the rotation of AdCycle requires more than one advertisement at the time of posting, one of ordinary skill in the art would have not

contemplated combining the teachings of Evans and AdCycle. In other words, at the time of posting to a website, Evans fails to provide more than one advertisement to rotate according to the teachings of AdCycle.

Thus, the teachings of Evans and AdCycle cannot be combined to produce the claimed invention with a reasonable expectation of success or with at least some degree of predictability. Accordingly, the rejection of the claims under 35 U.S.C. § 103(a) be should be **REVERSED**.

3. Rejecting the claims based on the combination of Evans and AdCycle is the result of impermissible hindsight.

According to the *M.P.E.P.*, “impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.” *M.P.E.P.* § 2142. As discussed previously, Evans and AdCycle fail to teach or suggest assembling a plurality of aggregate creative forms associated with an aggregate creative, storing the assembled plurality of aggregate creative forms, and selecting and retrieving one of the previously assembled plurality of stored aggregate creative forms when the aggregate creative is selected for transmission to users on an electronic network by an advertising system, as required by independent claims 46, 63, and 80. Moreover, as also discussed previously, the teachings of Evans and AdCycle cannot be combined as suggested by the final Office Action to yield the claimed invention with a reasonable expectation of success or with at least some degree of predictability. Thus, the final Office Action’s attempt to stretch the teachings of Evans and AdCycle to arrive at the claimed invention where such teachings fail to exist strongly suggests that the final Office Action is applying impermissible hindsight.

In view of the foregoing, Appellants respectfully request that the rejection of independent claims 46, 63, and 80 under 35 U.S.C. § 103(a) be **REVERSED**. In addition, according to the *M.P.E.P.*, “[i]f an independent claim is nonobvious under 35 U.S.C. 103,

then any claim depending therefrom is nonobvious.” *M.P.E.P.* § 2143.03 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)). Therefore, claims 49-52, 54, 55, 59-62, 66-69, 71, 72, 76-79, 83-86, 88, 89, and 93-96 are also allowable based at least on their dependency on respective claims 46, 63, and 80.

C. The rejection of claims 47-48, 56, 64-65, 73, 81-82, and 90 under 35 U.S.C. § 103(a) as being unpatentable over Evans in view of AdCycle and in further view of Alao should be REVERSED.

Claims 47-48, 56, 64-65, 73, 81-82, and 90 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Evans in view of AdCycle and in further view of Alao. (*See* final Office Action, page 12, line 9-page 13, line 22.)¹ Appellants respectfully submit that these dependent claims are allowable at least for the same reasons as their respective base claims 46, 63, and 80. Alao fails to cure the deficiencies of Evans and AdCycle described above. In general, Alao appears to disclose an interactive television environment which displays a single list of advertisements that is selected in real time, *i.e.*, when the server is ready to display the advertisements. *See* Alao, paragraph [0146]. Because Alao combines a single set of advertisements only at the time that they are supposed to be displayed, Alao does not disclose storing a plurality of creative aggregate forms or selecting an aggregate creative form from such a plurality when the corresponding aggregate creative is selected for transmission, as recited by independent claims 46, 63, and 80. Indeed, Also is only cited by the final Office Action for teaching the use of weightings or constraints for the selection of advertisements. (*See* final Office Action, page 13, lines 9-10.) Accordingly, Appellants

¹ Appellants note that the final Office Action refers to “Yasnovsky” instead of Alao. It is assumed that the reference is a typographical error and that the final Office Action actually intends to make reference to the teachings of Alao.

respectfully request that the rejection of claims 19, 20, 36, 37, 63, 64, 80, and 81 under 35 U.S.C. § 103(a) be **REVERSED**.

D. The rejection of claims 53, 58, 70, 75, 87, and 92 under 35 U.S.C. § 103(a) as being unpatentable over Evans in view of AdCycle and in further view of Larson should be REVERSED.

Claims 53, 58, 70, 75, 87, and 92 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Evans in view of AdCycle and in further view of Larson. (*See* final Office Action, page 14, line 1-page 15, line 11.)² Appellants respectfully submit that these dependent claims are allowable at least for the same reasons as their respective base claims 46, 63, and 80. Larson fails to cure the deficiencies of Evans and AdCycle described above. In general, Larson appears to disclose a digital edition of a newspaper or magazine having a single set of individual advertisement images that are based on “existing display advertising, such as hard copy or other print-formatted copy” and that are combined in real time and “made ‘live’ when the linking HTML web page is uploaded.” Larson, paragraphs [0005], [0137]. Because Larson combines a single set of advertisements only at the time that they are supposed to be displayed, Larson does not disclose storing a plurality of creative aggregate forms or selecting an aggregate creative form from such a plurality when the corresponding aggregate creative is selected for transmission, as recited by independent claims 46, 63, and 80. Indeed, Larson is only cited by the final Office Action for teaching the an advertisement containing active links/hyperlinks to an advertsier’s website. (*See* final Office Action, page 14, lines 9-10.) Accordingly, Appellants respectfully request that the rejection of claims 53, 58, 70, 75, 87, and 92 under 35 U.S.C. § 103(a) be **REVERSED**.

² Appellants note that the final Office Action refers to “Yasnovsky” instead of Larson. It is assumed that the reference is a typographical error and that the final Office Action actually intends to make reference to the teachings of Larson.

E. The rejection of claims 57, 74, and 91 under 35 U.S.C. § 103(a) as being unpatentable over Evans in view of AdCycle and in further view of Aphek should be REVERSED.

Claims 57, 74, and 91 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Evans in view of AdCycle and in further view of Aphek. (*See* final Office Action, page 15, line 12-page 16, line 9.) Appellants respectfully submit that these dependent claims are allowable at least for the same reasons as their respective base claims 46, 63, and 80. Aphek fails to cure the deficiencies of Evans and AdCycle described above. In general, Aphek appears to disclose the generation and update of a single web advertisement. *See* Aphek, paragraphs [0033]-[0034], [0036]. Aphek does not disclose storing a plurality of assembled creative aggregate forms or selecting an aggregate creative form from such a plurality when the corresponding aggregate creative is selected for transmission, as recited by independent claims 46, 63, and 80. Indeed, Aphek is only cited by the final Office Action for teaching the off-line creation of a single advertisement. (*See* final Office Action, page 15, lines 18-20.) Accordingly, Appellants respectfully request that the rejection of claims 57, 74, and 91 under 35 U.S.C. § 103(a) be **REVERSED**.

VIII. CONCLUSION

For all of the reasons discussed above, Appellants respectfully submit that all pending claims 46-96 define allowable subject matter under 35 U.S.C. §§ 101 and 103(a). Accordingly, Appellants respectfully request that this Honorable Board reverse the rejections of claims 46-96.

Except for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required,

including any required extension of time fees, or credit any overpayment to Deposit Account No. 19-2380. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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Date: May 14, 2010

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IX. CLAIMS APPENDIX

The following is a complete listing of claims in the application.

1-45. (Cancelled)

46. (Previously Amended) A method for the automated generation and serving of aggregate creatives, comprising the steps of:

receiving an aggregate creative definition, the aggregate creative definition being associated with an aggregate creative that is selectable by an advertising system;

selecting, in accordance with the aggregate creative definition, at least one set of more than one subcreative from a plurality of subcreatives in the advertising system;

assembling, in accordance with the aggregate creative definition, a plurality of aggregate creative forms, comprising the steps of:

rotating through the at least one set of more than one subcreative; and

selecting, during the step of rotating, a plurality of subsets of subcreatives to be included in the plurality of aggregate creative forms, the plurality of subsets of subcreatives including different combinations of more than one subcreative; and

storing the plurality of aggregate creative forms, the plurality of aggregate creative forms associated with the aggregate creative in the advertising system as assembled forms; and

when the aggregate creative is selected for transmission to users on an electronic network by the advertising system, selecting one of the previously assembled plurality of stored aggregate creative forms associated with the aggregate creative, and retrieving the selected aggregate creative form for the transmission.

47. (Previously Presented) The method according to claim 46, further comprising applying weighting criteria to the selected set of subcreatives, wherein the step of selecting a plurality of subsets of subcreatives comprises the step of selecting a plurality of subsets of subcreatives according to the weighting criteria.

48. (Previously Presented) The method according to claim 47, wherein the step of applying weighting criteria comprises the step of generating copies of weighted subcreatives in the at least one set of subcreatives in accordance with the weighting criteria.

49. (Previously Presented) The method according to claim 46, wherein the aggregate creative appears to rotate subcreatives when the step of selecting one of the aggregate creative forms and the step of retrieving the selected aggregate creative form for the transmission are repeated.
50. (Previously Presented) The method according to claim 46, wherein the at least one set of subcreatives includes a plurality of sets of subcreatives and the plurality of subsets of subcreatives are selected from each set of subcreatives.
51. (Previously Presented) The method according to claim 50, wherein the plurality of aggregate creative forms includes subsets of subcreatives from more than one of the plurality of sets of subcreatives.
52. (Previously Presented) The method according to claim 50, wherein the aggregate creative appears to rotate subcreatives from more than one of the plurality of sets of subcreatives when the step of selecting one of the aggregate creative forms and the step of retrieving the selected aggregate creative form are repeated.
53. (Previously Presented) The method according to claim 50, wherein the plurality of sets of subcreatives includes graphic subcreatives, text subcreatives, and hyperlink subcreatives.
54. (Previously Presented) The method according to claim 50, wherein the plurality of sets of subcreatives includes different numbers of subcreatives.
55. (Previously Presented) The method according to claim 50, wherein at least two of the sets of subcreatives share one or more common subcreatives.
56. (Previously Presented) The method according to claim 46, wherein the aggregate creative definition includes one or more constraints for the step of selecting at least one set of subcreatives, the one or more constraints determining permitted combinations of subcreatives for the plurality of subsets of subcreatives.
57. (Previously Presented) The method according to claim 46, wherein the step of assembling a plurality of aggregate creative forms occurs off-line from when the aggregate creative is selected for transmission.

58. (Previously Presented) The method according to claim 46, further comprising the step of tracking transmitted subcreatives transmitted to users on the electronic network.
59. (Previously Presented) The method according to claim 46, wherein at least one of the steps of selecting at least one set of subcreatives, selecting a plurality of subsets of subcreatives, and assembling a plurality of aggregate creative forms is further executed according to scheduling criteria for transmission to users.
60. (Previously Presented) The method according to claim 46, wherein at least one of the steps of selecting at least one set of subcreatives, selecting a plurality of subsets of subcreatives, and assembling a plurality of aggregate creative forms is further executed according to criteria for targeting transmission to specific users.
61. (Previously Presented) The method according to claim 46, wherein the aggregate creative definition enables the step of assembling a plurality of aggregate creative forms to occur even if a prescribed number of subcreatives is not available in one of the subsets of subcreatives.
62. (Previously Presented) The method according to claim 46, wherein the advertising system is configured to select aggregate creatives and non-aggregate creatives for transmission to users on the electronic network.
63. (Previously Presented) A system for the automated generation and serving of aggregate creatives, comprising:
- means for the receiving an aggregate creative definition, using a computer processor, the aggregate creative definition being associated with an aggregate creative that is selectable by an advertising computer system;
 - means for selecting, in accordance with the aggregate creative definition, using a computer processor, at least one set of more than one subcreative from a plurality of subcreatives in the advertising computer system;
 - means for assembling, in accordance with the aggregate creative definition, using a computer processor, a plurality of aggregate creative forms, the means for assembling comprising:
 - means for rotating through the at least one set of more than one subcreative;
 - and

means for selecting, during the step of rotating, a plurality of subsets of subcreatives to be included in the plurality of aggregate creative forms, the plurality of subsets of subcreatives including different combinations of more than one subcreative; and

means for storing the plurality of aggregate creative forms, the plurality of aggregate creative forms associated with the aggregate creative in the advertising computer system;

means for selecting, using a computer processor, one of the plurality of stored aggregate creative forms associated with the aggregate creative, when the aggregate creative is selected for transmission to users on an electronic network by the advertising computer system as assembled forms; and

means for retrieving, using a computer processor, the previously assembled selected aggregate creative form for transmission to users on an electronic network, when the aggregate creative is selected for the transmission to users on the electronic network by the advertising computer system.

64. (Previously Presented) The system according to claim 63, further comprising means for applying weighting criteria to the selected set of subcreatives, wherein the means for selecting a plurality of subsets of subcreatives comprises means for selecting a plurality of subsets of subcreatives according to the weighting criteria.

65. (Previously Presented) The system according to claim 64, wherein the means for applying weighting criteria comprises means for generating copies of weighted subcreatives in the at least one set of subcreatives in accordance with the weighting criteria.

66. (Previously Presented) The system according to claim 63, wherein the aggregate creative appears to rotate subcreatives when the aggregate creative forms are transmitted.

67. (Previously Presented) The system according to claim 63, wherein the at least one set of subcreatives includes a plurality of sets of subcreatives and the plurality of subsets of subcreatives are selected from each set of subcreatives.

68. (Previously Presented) The system according to claim 67, wherein the plurality of aggregate creative forms includes subsets of subcreatives from more than one of the plurality of sets of subcreatives.

69. (Previously Presented) The system according to claim 67, wherein the aggregate creative appears to rotate subcreatives from more than one of the plurality of sets of subcreatives when the aggregate creative forms are transmitted.
70. (Previously Presented) The system according to claim 67, wherein the plurality of sets of subcreatives includes graphic subcreatives, text subcreatives, and hyperlink subcreatives.
71. (Previously Presented) The system according to claim 67, wherein the plurality of sets of subcreatives includes different numbers of subcreatives.
72. (Previously Presented) The system according to claim 67, wherein at least two of the sets of subcreatives share one or more common subcreatives.
73. (Previously Presented) The system according to claim 63, wherein the aggregate creative definition includes one or more constraints for the means for selecting at least one set of subcreatives, the one or more constraints determining permitted combinations of subcreatives for the plurality of subsets of subcreatives.
74. (Previously Presented) The system according to claim 63, wherein the means for assembling a plurality of aggregate creative forms is operated off-line from when the aggregate creative is selected for transmission.
75. (Previously Presented) The system according to claim 63, further comprising means for tracking transmitted subcreatives transmitted to users on the electronic network.
76. (Previously Presented) The system according to claim 63, wherein at least one of the means for selecting at least one set of subcreatives, the means for selecting a plurality of subsets of subcreatives, and the means for assembling a plurality of aggregate creative forms operates in accordance with scheduling criteria for transmission to users.
77. (Previously Presented) The system according to claim 63, wherein at least one of the means for selecting at least one set of subcreatives, the means for selecting a plurality of subsets of subcreatives, and the means for assembling a plurality of aggregate creative forms operates in accordance with criteria for targeting transmission to specific users.

78. (Previously Presented) The system according to claim 63, wherein the aggregate creative definition enables an aggregate creative form to be assembled even if a prescribed number of subcreatives is not available in one of the subsets of subcreatives.

79. (Previously Presented) The system according to claim 63, wherein the advertising system is configured to select aggregate creatives and non-aggregate creatives for transmission to users on the electronic network.

80. (Previously Presented) A program product comprising a computer-readable storage device containing instructions recorded thereon, operable on a computer for the automated generation and serving of aggregate creatives, the instructions operable to be executed by the computer to perform the steps of:

- receiving an aggregate creative definition, the aggregate creative definition being associated with an aggregate creative that is selectable by an advertising system;

- selecting, in accordance with the aggregate creative definition, at least one set of more than one subcreative from a plurality of subcreatives in the advertising system;

- assembling, in accordance with the aggregate creative definition, a plurality of aggregate creative forms

- comprising the steps of:

- rotating through the at least one set of more than one subcreative; and

- selecting, during the step of rotating, a plurality of subsets of subcreatives to be included in the plurality of aggregate creative forms, the plurality of subsets of subcreatives including different combinations of more than one subcreative;

- storing the plurality of aggregate creative forms, the plurality of aggregate creative forms associated with the aggregate creative in the advertising system as assembled forms; and

- when the aggregate creative is selected for transmission to users on an electronic network by the advertising system, selecting one of the previously assembled plurality of stored aggregate creative forms associated with the aggregate creative, and retrieving the selected aggregate creative form for the transmission.

81. (Previously Presented) The program product according to claim 80, wherein the instructions further comprise the step of applying weighting criteria to the selected set of

subcreatives, and the plurality of subsets of subcreatives are selected according to the weighting criteria.

82. (Previously Presented) The program product according to claim 81, wherein the step of applying weighting criteria comprises the step of generating copies of weighted subcreatives in the at least one set of subcreatives in accordance with the weighting criteria.

83. (Previously Presented) The program product according to claim 80, wherein the aggregate creative appears to rotate subcreatives when the step of selecting one of the aggregate creative forms and the step of retrieving the selected aggregate creative form are repeated.

84. (Previously Presented) The program product according to claim 80, wherein the at least one set of subcreatives includes a plurality of sets of subcreatives and the plurality of subsets of subcreatives are selected from each set of subcreatives.

85. (Previously Presented) The program product according to claim 84, wherein the aggregate creative forms include subsets of subcreatives from more than one of the plurality of sets of subcreatives.

86. (Previously Presented) The program product according to claim 84, wherein the aggregate creative appears to rotate subcreatives from more than one of the plurality of sets of subcreatives when the step of selecting one of the aggregate creative forms and the step of retrieving the selected aggregate creative form are repeated.

87. (Previously Presented) The program product according to claim 84, wherein the plurality of sets of subcreatives includes graphic subcreatives, text subcreatives, and hyperlink subcreatives.

88. (Previously Presented) The program product according to claim 84, wherein the plurality of sets of subcreatives include different numbers of subcreatives.

89. (Previously Presented) The program product according to claim 84, wherein at least two of the sets of subcreatives share one or more common subcreatives.

90. (Previously Presented) The program product according to claim 80, wherein the aggregate creative definition includes one or more constraints for the step of selecting at least

one set of subcreatives, the one or more constraints determining permitted combinations of subcreatives for the plurality of subsets of subcreatives.

91. (Previously Presented) The program product according to claim 80, wherein the step of assembling a plurality of aggregate creative forms occurs off-line from when the aggregate creative is selected for transmission.

92. (Previously Presented) The program product according to claim 80, further comprising the step of tracking transmitted subcreatives transmitted to users on the electronic network.

93. (Previously Presented) The program product according to claim 80, wherein at least one of the steps of selecting at least one set of subcreatives, selecting a plurality of subsets of subcreatives, and assembling a plurality of aggregate creative forms is further executed according to scheduling criteria for transmission to users.

94. (Previously Presented) The program product according to claim 80, wherein at least one of the steps of selecting at least one set of subcreatives, selecting a plurality of subsets of subcreatives, and assembling a plurality of aggregate creative forms is further executed according to criteria for targeting transmission to specific users.

95. (Previously Presented) The program product according to claim 80, wherein the aggregate creative definition enables the step of assembling a plurality of aggregate creative forms to occur even if a prescribed number of subcreatives is not available in one of the subsets of subcreatives.

96. (Previously Presented) The program product according to claim 80, wherein the advertising system is configured to select aggregate creatives and non-aggregate creatives for transmission to users on the electronic network.

X. EVIDENCE APPENDIX

LIST OF EVIDENCE

EXHIBIT

Appellants' Response filed October 23, 2008 with Amendments to Specification	A
Dictionary definition for "personal computer"	B
Dictionary definitions for "mainframe computer" and "mainframe"	C
Dictionary definitions for "storage device" and "storage"	D

XI. RELATED PROCEEDINGS APPENDIX

None.